

REMARKS

Claims 1-19 are pending in the application. No claims have been amended, added or canceled. Thus, claims 1-19 remain subject to continued examination.

ART REJECTIONS:

Each of the independent claims (1, 10 and 19) stands rejected under 35 U.S.C. 103(a) as being obvious over the prior practice of using a label with one adhesive free end in view of either U.S. Patent 5,351,426 to Voy et al. or U.S. Patent 5,098,759 to Felix. No other rejections have been applied to the independent claims. At this time Applicants respectfully traverse the outstanding rejection of the independent claims on grounds that the combination of art relied upon (acknowledged prior labeling practices plus the teachings of the cited patents) is contrary to the accepted wisdom in the art and that the art relied upon would not have provided the requisite suggestion to proceed against the accepted wisdom. Thus, it is respectfully submitted that the independent claims and all claims depending therefrom stand in condition for allowance.

The prior art must be considered in its entirety including portions that would lead away from the claimed invention. In addition, as pointed out at MPEP §2116, in a claim directed to a process, the materials on which a process is carried out must be accorded weight in determining patentability of the process.

In the Office Action the primary art relied upon is the acknowledged prior practice of placing labels with an adhesive free end along the length of a moving web such that the adhesive free portion projects outwardly from the edge. The Office Action then relies upon the disclosure of labels in Voy et al. and Felix having adhesive free zones at several locations to conclude that it would have been obvious to modify the prior practice of marking moving webs with labels having a single adhesive free end to use labels having two adhesive free ends motivated by the desire to achieve advantages such as minimizing contact between the label and the carrier strip. Applicants respectfully disagree.

The prior art must be considered in its entirety including portions that would lead away from the claimed invention. In the present instance the primary prior art relied upon is the practice of marking a moving web by placing a label with a single adhesive free end along the edge such that the adhesive free end projects outwardly. While this practice does reflect the fact that it was known to place a label with an adhesive free end along the edge of the moving web, this practice also reflects the prior accepted wisdom that the end of the label inboard of the edge should be substantially covered by adhesive.

As stated at page 2, paragraph 1 of the previously submitted declaration of Joseph Egan, the accepted wisdom in the art of labeling moving webs has been to substantially avoid adhesive free label zones at inboard locations so as to reduce the possibility that the label will fall off of the rapidly moving web. The primary prior art practice relied upon by the Office Action reflects this thinking. Moreover, as further pointed out in the Egan declaration, this thinking has been so prevalent that label manufactures have traditionally produced two different versions of labels with single adhesive free ends oriented in either right handed or left handed orientation depending upon the contemplated placement. The willingness to increase complexity by having two different product offerings further reflects the perceived need to have adhesive across the inboard end.

As best understood, the labels in the secondary references to Voy et al. and Felix are not identified as being suitable for placement on a moving web. To the contrary, the fact that such labels are printable indicates that they are intended for placement on stationary articles where the labels can be read. Thus, the mere fact that such references disclose labels of some type with multiple adhesive free zones would not have necessarily indicated the ability to use such labels in marking a rapidly moving web. To the contrary, since the patterns of adhesive free zones are utilized for the purpose of making the label easy to release, it is respectfully submitted that there would have actually been a perceived disincentive to modify the prior art web labeling practices in the manner proposed by the Office Action due to a concern that the attachment would not be sufficiently secure to maintain placement.

The case law and the MPEP recognize that proceeding contrary to the accepted wisdom in the art is evidence of nonobviousness. MPEP §2145 citing *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986). In the present instance, as indicated in the Egan declaration the accepted wisdom has been that when labeling a moving web adhesive free inboard zones should be avoided to reduce the possibility that the label will fall off. Moreover, the secondary references to Voy et al. and Felix actually appear to lend some support to this fear by indicating that the patterned adhesive makes the labels easier to remove from a backing web. The present invention thus proceeds contrary to the accepted wisdom.

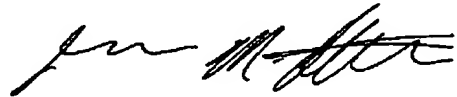
Applicants respectfully point out that in a process claim the work piece must be considered and the mere fact that references can be combined or modified does not render the resultant combination or modification obvious, unless the prior art also suggests the desirability of the combination. Applicants respectfully submit that when the prior art references and practices are considered in their entirety, such practices and teachings weigh against the modification to the prior art practice proposed by the Office Action since such a modification would be contrary to the accepted wisdom relating to marking moving webs.

CONCLUSION:

For the reasons set forth above, it is respectfully submitted that the cited art does not support a continued obviousness rejection and that all claims stand in condition for allowance. Prompt allowance and passage to issue is therefore requested. While Applicants have attempted to address all outstanding issues, in the event that any issue remains unresolved, the Examiner is encouraged to contact the undersigned attorney in the hope that such issue may be resolved in an expedient and satisfactory manner.

A petition for a two month extension of time accompanies this response. To any extent required, a petition for an additional extension of time is hereby made. Authorization is hereby provided to deduct the extension fee and any additional fee necessary for the acceptance of this paper from Deposit Account 50-1424.

Respectfully submitted,



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